

**REMARKS**

Applicants propose to amend claim 1 to more appropriately define the claimed subject matter. Claims 1-3, 5, and 6 are pending in this application.

**Improper Finality of Office Action mailed September 8, 2006**

The Office Action mailed September 8, 2006 ("the Office Action"), was improperly made final because the rejections are on newly cited art, other than information submitted in an information disclosure statement (IDS) filed under 37 CFR 1.97(c). "[A] second or any subsequent action on the merits in any application or patent undergoing reexamination proceedings will not be made final if it includes a rejection, on newly cited art, other than information submitted in an information disclosure statement filed under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p), of any claim not amended by applicant or patent owner in spite of the fact that other claims may have been amended to require newly cited art." MPEP § 706.07(a).

Applicants filed an IDS ("the IDS") on July 6, 2006. However, the rejections in the Office Action are based on newly cited art that was not submitted in the IDS. For example, U.S. Patent Application Publication No. 2002/0049546 to Shimomura and U.S. Patent No. 2,842,135 to Browner, on which the rejections were grounded, were not submitted in the IDS. Rather, these references were newly cited by the Examiner in the Office Action. Thus, the finality of the Office Action should be withdrawn.

**§ 102(a) Rejection of Claims 1-3 over *Shimomura***

Applicants respectfully traverse the rejection of claims 1-3 under 35 U.S.C. § 102(a) as anticipated by U.S. Patent Application Publication No. 2002/0049546 to Shimomura ("*Shimomura*").

To properly anticipate Applicants' claims under 35 U.S.C. § 102, each and every element as set forth in the claim must be found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. *Shimomura* fails to disclose each and every element recited in independent claim 1, from which claims 2 and 3 depend.

For example, *Shimomura* does not disclose a display equipment comprising, inter alia, "a belt including a plurality of electrodes in contact to the surface of the body," as recited in amended claim 1 (emphasis added).

Instead, *Shimomura* teaches, "a body type determination apparatus 10 comprises a bi[o]electric impedance meter 20 equipped with a weight scale and a control box 40" (paragraph [0039]). "[T]he bioelectric impedance meter 20 equipped with the weight scale comprises: the constant current feeding electrodes 21a and 21b; ... the voltage measuring electrodes 22a and 22b; a voltage measuring circuit 24 functioning as an impedance measurement device for measuring a voltage between said voltage measuring electrodes 22a and 22b; [and] a body weight measuring unit 25 functioning as a body weight measurement device for measuring a body weight of a subject" (paragraph [0041]). "[T]he control box 40 comprises: a data input device 41" (paragraph [0042]).

The bioelectric impedance meter (20) in *Shimomura*, which is equipped with the weight scale and comprises the electrodes (21a, 21b), does not constitute “a belt including a plurality of electrodes in contact to the surface of the body,” as recited in amended claim 1 (emphasis added). As shown in Figure 1 of *Shimomura*, the bioelectric impedance meter (20) is equipped with the weight scale such that the subject stands on the bioelectric impedance meter (20). When the subject stands on the bioelectric impedance meter (20), the soles of the subject’s feet contact the electrodes (21a, 21b) and the subject’s weight is also measured by the weight scale. This bioelectric impedance meter (20) with the weight scale does not constitute a “belt.” Thus, *Shimomura* fails to disclose “a belt including a plurality of electrodes in contact to the surface of the body,” as required by claim 1.

In addition, *Shimomura* does not disclose “means for calculating each approximate value of bone weight, water weight, and/or muscular weight of the body on the basis of the measured impedance and said personal information,” as recited in claim 1 (emphasis added).

According to *Shimomura*, “the BMI [(body mass index)], FMI [(fat mass index)] and LMI [(lean mass index)] are calculated based on the measured body weight, BI [(bioelectric impedance)] and set body height” (paragraph [0050]). “[T]he equation: (body weight) - (body fat mass) = (lean mass) is used to determine the lean mass, from which the LMI is determined by the equation:  $LMI = \text{lean mass} / \text{height}^2$ ” (paragraph [0060]). The lean mass includes “muscles” and “bones” (paragraph [0087]). “In an actual display, the representation [of the BMI and FMI, or the BMI and LMI] may be provided” (paragraph [0065]).

*Shimomura* further teaches that “although in the above-described representation mode, the LMI has been indicated as an index of the lean tissue, the representation mode may be modified so that the LMI may be treated as an index of the muscular tissue ... [P]roviding an indication of whether the muscle mass being more or less rather than the indication of the lean tissue mass, which is unfamiliar word to the ordinary people, can help the subject understand the indication more easily.” ([Paragraph 0107].)

However, calculating an approximate value of the lean mass index (LMI), as in *Shimomura*, does not constitute “calculating ... [an] approximate value of the ... muscular weight of the body,” as required by claim 1 (emphasis added). The “lean tissue” (whose mass is measured in the LMI) includes at least muscles and bones. However, bones are not a type of “muscle.” Furthermore, claim 1 expressly distinguishes “bone weight” from “muscular weight.” Therefore, the term “muscular weight,” as recited in claim 1, cannot be read to include “bone weight,” since bone is not a type of muscle. Thus, calculating lean mass does not constitute “calculating ... muscular weight,” as recited in claim 1.

The visual representation of the lean mass index as an indicator of whether “muscle mass [is] more or less” to a human operator, as in *Shimomura*, does not convert the lean mass index into an actual measure of “muscular weight” as distinguished from bone weight. As explained above, calculating lean mass does not constitute calculating “muscular weight.” Rather, *Shimomura* displays the lean mass index to a human user as a relative indicator of muscle mass merely for the purpose of “help[ing] the subject understand the indication more easily.” In contrast, the equipment

recited in claim 1 calculates the “muscular weight” as distinguished from the “bone weight.”

Thus, since *Shimomura* does not disclose each and every element of claim 1, claim 1 and claims 2 and 3, which depend therefrom, are allowable over *Shimomura* under § 102(a).

**§ 103(a) Rejection of Claims 5 and 6 over *Shimomura* and *Browner***

Applicants respectfully traverse the rejection of claims 5 and 6 under 35 U.S.C. § 103(a) as unpatentable over *Shimomura* in view of U.S. Patent No. 2,842,135 to Browner (“*Browner*”) because a *prima facie* case of obviousness has not been established.

To establish a *prima facie* case of obviousness under § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Moreover, both of these requirements must be found in the prior art, not in applicant's disclosure. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP § 2143 (8th ed., Rev. 4, October 2005).

For example, *Shimomura* does not teach or suggest each and every element recited in independent claim 1, from which claims 5 and 6 depend, for at least the reason that, as set forth above, *Shimomura* fails to teach or suggest “a belt including a plurality of electrodes in contact to the surface of the body” or “means for calculating

each approximate value of bone weight, water weight, and/or muscular weight of the body on the basis of the measured impedance and said personal information," as recited in claim 1.

*Browner* does not make up for the deficiencies of *Shimomura* because *Browner* also fails to teach or suggest "a belt including a plurality of electrodes in contact to the surface of the body" or "means for calculating each approximate value of bone weight, water weight, and/or muscular weight of the body on the basis of the measured impedance and said personal information," as recited in claim 1, and the Examiner does not rely on *Browner* for any teaching or suggestion of these limitations.

Thus, for at least the reason that *Shimomura* and *Browner* do not teach or suggest each and every element of claim 1, claim 1 and claims 5 and 6, which depend therefrom, are allowable over *Shimomura* and *Browner* under § 103(a).

### **CONCLUSION**

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-3, 5, and 6 in condition for allowance.


In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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